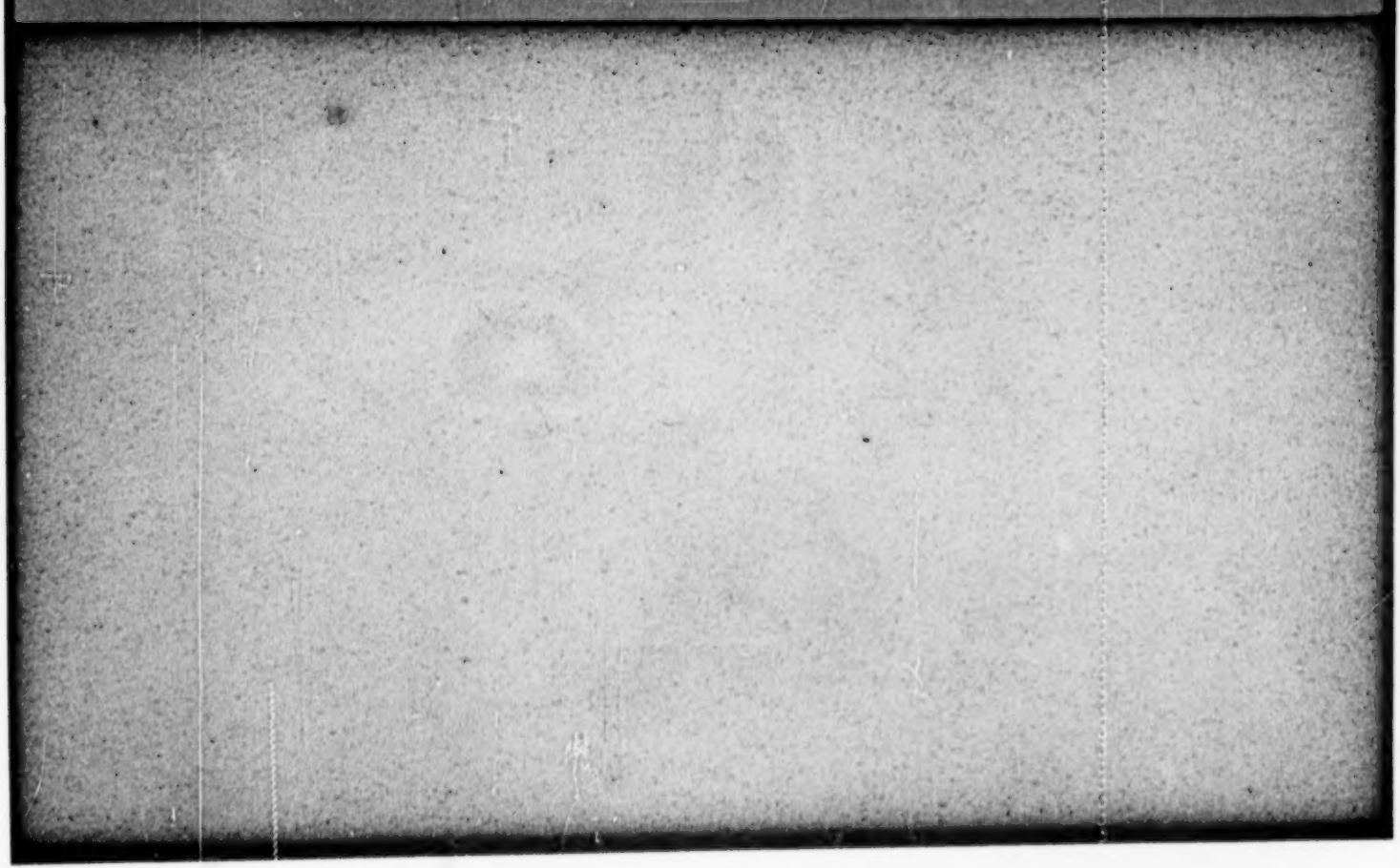

SUPREME COURT, U. S.

JUN 4 1974

MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1973

No. 73-1677

BORG-WARNER CORPORATION,
Petitioner,

vs.

KING-SEELEY THERMOS CO.,
Respondent.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

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COUNTERSTATEMENT OF QUESTIONS PRESENTED

Petitioner (hereinafter called "Borg-Warner") lists two questions for consideration by this Court. Respondent (hereinafter called "King-Seeley") submits however that based on

the proceedings in this matter the question Borg-Warner has really raised is:

1. Is a patent which fully illustrates, discloses and claims a novel machine invalid under the provisions of 35 U.S.C. 112 because it fails to mention one of the many functions of the machine.

SUPPLEMENTAL STATEMENT OF THE CASE

This is the last of a long line of patent infringement cases brought by King-Seeley against a number of companies who infringed King-Seeley's United States Patent (U. S. Patent No. 2,753,694, hereinafter referred to as the " '694 patent"). The patent discloses and claims a machine for making chip or flake ice and is a basic patent covering an invention which revolutionized the art of making such ice. Only claim 4 of the patent is here in suit and as pointed out in the District Court decision Finding of Fact No. 9 (which appears on page 5a of the Appendix to Borg-Warner's Petition) this patent claim has been held valid in each of those prior suits.

Petitioner in its Statement of the Case attempts to convey the impression that the '694 patent fails to describe the patented machine in terms which would enable any person skilled in the art to make and use the same and that claim 4 does not claim the machine of the invention,

all as required by 35 U.S.C. 112. Nothing could be further from the truth. The '694 patent does fully disclose a machine which produces satisfactory chip or flake ice and Borg-Warner made no contention during the trial of this case nor in the briefs before the District Court or the Court of Appeals that claim 4 was invalid under 35 U.S. C. 112. In fact, in its brief to the Seventh Circuit Court of Appeals, Borg-Warner stated that it is aware of the rule that an inventor is entitled to all of the benefits of his invention, and if something is inherent in his machine, he is entitled to those benefits whether he knew them or not, but there is no inherency in this case. Thus, in the District Court and in the Court of Appeals, Borg-Warner only argued that a machine made in accordance with the disclosure of the '694 patent would not inherently compress the rising column of ice. The contrary was found to be true by the District Court after it witnessed various courtroom demonstrations of the machine illustrated and disclosed in the '694 patent in suit.

The argument that the ice disintegrating and removing member in the upper end of the cylinder of the machine shown in the '694 patent would not inherently compress the rising column of ice was made in all of the prior litigation involving the '694 patent and rejected by every court including the Tenth Circuit Court of Appeals, the Seventh Circuit Court of Appeals and the Sixth Circuit Court of Appeals. For instance, the Tenth Circuit Court of

Appeals stated in the case of King-Seeley Thermos Co. v. Refrigerated Dispensers, Inc., 354 F.2d 533

> "We think that Claim 4 of the 694 Patent clearly discloses a process of making a column of slush ice, or soft ice, in a freezing compartment, and then compressing it against the breaker-head, by means of an auger, for disintegration and removal of excess water; this is new and novel. The breaker-head serves no other purpose. Furthermore, even though the patent claim did not specifically use the terms 'slush ice', and 'compression', the patentee is entitled to all the benefits and advantages of his patent. Radio Corp. of America v. Radio Engineering Laboratories, 293 U.S. 1, 55 S. Ct. 928, 79 L. Ed. 163, reh. denied 293 U.S. 522, 55 S. Ct. 66, 79 L. Ed. 634; Talon, Inc. v. Union Slide Fastener, Inc., 9 Cir., 266 F.2d 731; Tropic-Aire, Inc. v. Cullen-Thompson Motor Co., 10 Cir., 107 F.2d 671; Byers Machine Co. v. Keystone Driller Co., 6 Cir., 44 F.2d 283, cert. denied 293 U.S. 572, 55 S. Ct. 103, 79 L. Ed. 670; Horton Mfg. Co. v. White Lily Mfg. Co., 7 Cir., 213 F.471."

The '694 patent in suit discloses and covers the first successful flake ice machines made by King-Seeley and those machines were commercially sold. King-Seeley obtained a later patent, U. S. Patent No. 2,825,209 (hereafter called the " '209" patent), which discloses an improved version of the '694 patent machine wherein the ice disintegrating and removing member has two mold board surfaces and the freezing cylinder has two outlet windows which are smaller in size than the window in the '694 machine so that the rising column of ice is compressed even more than in the '694 patent machine. This later '209 patent cannot be used to invalidate the earlier '694 patent here in suit and the prior courts have so held.

The District Court here had an opportunity in courtroom demonstrations to see how a machine, made exactly in accordance with what is disclosed and claimed in the '694 patent, operated and to see how it made satisfactory chip or flake ice and the District Court had an opportunity to see how the prior art which did not employ the ice disintegrating and removing member called for in the '694 patent failed to make satisfactory ice. Furthermore, the District Court saw that the ice disintegrating and removing member of the '694 patent did compress the rising column of ice and this along with its other functions of breaking up the rising column of ice into chips or flakes and guiding the flakes out of the freezing cylinder so that the machine did not jam, are what made the '694 patent machine the highly successful

machine it has been. Claim 4 of the '694 patent specifically claims this machine and the machine is disclosed in detail in the patent specification and all of the prior courts have found that the fact that the patent fails to mention one of these functions of the ice disintegrating and removing member does not render the patent invalid and Borg-Warner has failed to cite any law to support its contention to the contrary.

REASONS FOR DENYING THE WRIT

1. The '694 Patent Fully Conforms with The Requirements of 35 U.S.C. 112

As pointed out above there is no evidence in the record of this case to support Borg-Warner's contention that the '694 patent is invalid under 35 U.S.C. 112. In the lower courts Borg-Warner contended that in the '694 patent machine compressing of the rising column of slush ice by the ice disintegrating and removing member not only did not occur but was not mentioned in the patent. The lower courts here, as in all the prior cases, found that a machine constructed in accordance with the disclosure of the '694 patent did compress the rising column of ice. This is a factual determination which should not be reversed unless clearly erroneous and Borg-Warner has not even contended that there is any such error.

King-Seeley's later issued '209 patent covers an improved version of the '694 patent

machine which operates on the same principle as that machine but makes an improved ice and is not relevant to any issue relating to the validity of the earlier '694 patent.

2. There is No Conflict Between Circuits

Borg-Warner argues on page 9 of its Petition that the Second Circuit Court of Appeals in the recent case of Carter-Wallace, Inc. v. Otte, 474 F. 2d 529 held contrary to the Seventh Circuit Court of Appeals in this case on the questions presented. This statement is not true. The facts in the Carter-Wallace case were completely different than the facts here and the principles of law involved are completely different. The Carter-Wallace case was a pharmaceutical case where the patented chemical compound was described in the patent as only having utility as an anticonvulsant and muscle paralyzant. The chemical compound for these uses was found to be obvious in view of certain prior art. The Appellant argued however that this compound had been found to be an excellent tranquillizer and that the compound was not obvious as a tranquillizer even if it was as an anticonvulsant and muscle paralyzant. There was however no mention in the patent of its possible use as a tranquillizer and the court said that therefore the patentee could not overcome this obviousness defense by referring to something not disclosed or referred to in the patent.

This is not at all as the situation here. In this case the prior art did not have the ice disintegrating and removing member in the upper end of the ice forming cylinder as disclosed and claimed in the '694 patent. Every prior court has found the '694 patent valid over this prior art and a patent which fully discloses and claims inventive subject matter is certainly not invalid under any provisions of the law simply because it fails to mention one of the many functions of the patented machine, particularly when that function is inherent in the claimed machine and has been found to be so by a multitude of courts.

Again, here the invention is the machine and the patent does contain a full and complete description of the machine and Claim 4 does particularly point out and distinctly claim that invention so that the factual situation in this case is completely different from the Carter-Wallace case and all of the Circuit Courts of Appeals that have passed on the '694 patent have found it valid. Thus here we have the antithesis of a conflict between circuits.

CONCLUSION

Borg-Warner's Petition stating that all the prior Courts of Appeals have misinterpreted 35 U.S.C. 112 is a sham in view of the facts in this case. Not only has Borg-Warner not raised this issue in the lower courts but it has

no basis for doing so in view of the fact that the '694 patent does clearly disclose and claim the invention as required by the patent statute. There is no conflict between any of the circuits and in fact all have uniformly held the '694 patent valid. The '694 patent has now expired and there is certainly no matter of great national interest or need involved in this case.

For the reasons set forth above Respondent prays that the Writ of Certiorari be denied.

Respectfully submitted,

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